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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte GREGG D. SCHELLER and MICHAEL D. AULD

Appeal 2010-009083
Application 10/586,018
Technology Center 3700

Before LORA M. GREEN, JEFFREY N. FREDMAN, and
ERICA A. FRANKLIN, *Administrative Patent Judges*.

FRANKLIN, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) involving claims to a surgical instrument. The Patent Examiner rejected the claims as anticipated. We have jurisdiction under 35 U.S.C. § 6(b). We reverse.

STATEMENT OF THE CASE

Claims 1, 3-10, 12 and 13 are on appeal. Claim 1 is representative and reads as follows:

1. A surgical instrument handle comprising:

an elongate rod having a center axis that defines mutually perpendicular axial and radial directions, the rod having a length with axially opposite proximal and distal ends; the rod distal end being adapted to be attached to a surgical instrument head;

a piston mounted on the rod adjacent the rod distal end wherein the piston is adapted to have axially reciprocating movement toward and away from the rod distal end;

a forward grip member mounted on the rod wherein the forward grip member is adapted to have axial movement between first and second positions of the forward grip member relative to the rod, the forward grip member having a plurality of resilient arms that extend along the rod, the plurality of arms having distal ends that operatively engage with the piston whereby manual movement of the arm distal ends radially inwardly moves the piston axially toward the rod distal end and movement of the piston axially away from the rod distal end moves the arm distal ends radially outwardly, there being a first radial spacing between the arm distal ends when the forward grip member is in the first position relative to the rod, and there being a second radial spacing between the arm distal ends when the forward grip member is in the second position relative to the rod, the second radial spacing being larger than the first radial spacing.

The Examiner rejected claims 1, 3-10, 12 and 13 under 35 U.S.C. §102(b) as anticipated by Richards.[1]

ANTICIPATION

The Issue

The Examiner's position is:

> Richards discloses an elongate rod [14] adapted to be attached to a surgical instrument head [col. 4, 11. 10-12], a piston [34] mounted on the rod adjacent the rod distal end [Fig. 3], a forward grip member [20] having a plurality of resilient arms [20T, 20H, col. 3, 11. 25-31]

[1]US Patent No. 5,634,918 issued to William D. Richards, Jun. 3, 1997.

> that extend along the rod to operatively engage the piston [via elements 22 and 32], whereby manual movement of the arm distal ends radially inwardly [Fig. 4], moves the piston axially toward the rod distal end [Fig. 4], and movement of the piston axially away from the rod distal end moves the arm distal ends radially outwardly [Fig. 3]. If the first position is interpreted as seen in Fig. 4, and the second position is interpreted as seen in Fig. 3, the second radial spacing between elements 20H of each arm is larger than the first radial spacing.

(Ans. 3.)

In the Response to Argument section, the Examiner further characterized Richards' element 20, along with elements 20T and 20H, as the resilient arms. (Ans. 6.) According to the Examiner, "elements 20H are part of elements 20T, which together are interpreted by the examiner to comprise the distal end portions of the resilient arms." (*Id.* at 6-7.) The Examiner stated, "[l]ooking at the distal portion of arm 20, including 20T and 20H, as a whole, in Fig. 4 of Richards, which is considered the position in which the piston is moved toward the rod's distal end, the portion around label 20T can be seen as being moved radially inwardly compared to the position of the same spot in Fig. 3, wherein the piston is moved away from the rod's distal end." (*Id.* at 7.)

Appellants contend, among other things, that Richards did not disclose a "plurality of arms having distal ends that operatively engage with the piston whereby manual movement of the arm distal ends radially inwardly moves the piston axially toward the rod distal end and movement of the piston axially away from the rod distal end moves the arm distal ends radially outwardly," as required by independent claims 1, 3, and 8. (App. Br. 12.) According to Appellants, Richards' Figures 3 and 4 demonstrate

that when tie arm hooks 20H are moved toward the center axis 26 of the rod or radially inwardly, the piston 34 is moved away from the rod distal end rather than toward the rod distal end, as claimed. (*Id.*) Additionally, Appellants assert that when tie arm hooks 20H are moved away from the rod center axis 26 or radially outwardly, the piston 34 is moved toward the rod distal end 18, rather than away from the rod distal end, as claimed. (*Id.* at 10-11.)

Further, Appellants assert that the Examiner's interpretation of Richards erroneously characterized the six triggers 20 of Richards as two different elements of the claimed invention, i.e., both as the "forward grip member" and as the "plurality of resilient arms." (Reply Br. 2.)

The issue is whether Richards disclosed a "plurality of arms having distal ends that operatively engage with the piston whereby manual movement of the arm distal ends radially inwardly moves the piston axially toward the rod distal end."

Findings of Fact

1. Figure 3 of Richards is reproduced below:

FIG. 3

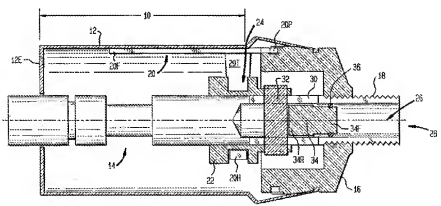

Figure 3 shows a cross-sectional view of a preferred embodiment of Richard's instrument in the unactuated state. (Richards col. 2, ll. 4-5.)

2. Figure 4 of Richards is reproduced below:

FIG. 4

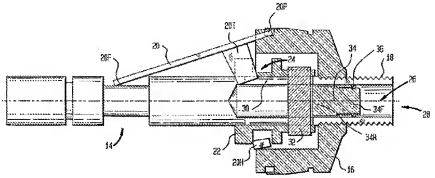

Figure 4 shows a cross-sectional view of the Fig. 3 embodiment in the actuated state, without the elastomeric boot. (*Id.* at col. 2, ll. 9-10.)

3. The Examiner relied on Figures 3 and 4 of Richards and found that Richards disclosed an instrument having an elongate rod 14, a piston 34 mounted on the rod adjacent the rod distal end, and a forward grip member 20 having a plurality of resilient arms 20T and 20H. (Ans. 3.)

4. In the Response to Argument, the Examiner further characterizes Richards' element 20, along with elements 20T and 20H, as the resilient arms. (Ans. 6.)

5. In the Response to Argument, the Examiner states that "elements 20H are part of elements 20T, which together are interpreted by the examiner to comprise the distal end portions of the resilient arms." (*Id.* at 6-7.)

6. In the Response to Argument, the Examiner states, "[l]ooking at the distal portion of arm 20, including 20T and 20H, as a whole, in Fig. 4 of Richards, which is considered the position in which the piston is moved toward the rod's distal end, the portion around label 20T can be seen as

being moved radially inwardly compared to the position of the same spot in Fig. 3, wherein the piston is moved away from the rod's distal end." (*Id.* at 7.)

7. Richards disclosed that each trigger 20 has a tie arm 20T, and each tie arm 20T is curved to circulate around the rod 14, and each tie arm 20T has a hook 20H at its distal end. (Richards col. 3, ll. 27-30.)

8. Richards disclosed that when the free end 20F of any trigger 20 is pressed radially inwardly towards the rod 14, the hook 20H at the end of the tie arm 20T presses against the grooved region 24 and urges the trigger retainer 22 to the right, as viewed in Figs. 3 and 4, causing all triggers 20 to move radially inwardly. (*Id.* at col. 3, ll. 42-46.)

9. Richards disclosed that as the trigger retainer 22 moves to the right, the pin 32 moves with it, which in turn pushes the slide piston 34, which moves to the right. (*Id.* at col. 4, ll. 38-40.)

10. Richards disclosed that when the slide piston 34 is moved to the left, it pushed the pin 32 and the trigger retainer 22 to the left and rotating the triggers 20 so their free ends 20F move radially outwardly. (*Id.* at col. 4, ll. 45-47.)

Principle of Law

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Analysis

We agree with Appellants that the Examiner improperly characterized Richards' element 20 as both the forward grip member as well as the plurality of resilient arms. (*See* FF 3-6.)

Moreover, we agree with Appellants that contrary to the Examiner's position (Ans. 6-7) Richards' element 20H, which the Examiner interpreted to be part of the distal end portion of the resilient arms (FF-5), did not "operatively engage with the piston whereby manual movement of the arm distal ends radially inwardly moves the piston axially toward the rod distal end," as required by the claimed invention. Rather, referring to Figures 3 and 4, Richards disclosed that when the *free end 20F* of any trigger 20 is pressed *radially inwardly* towards the rod 14, *hook 20H presses against the grooved region 24* and urges the trigger retainer 22 to the right, which ultimately results in the piston 34 to move to the right, i.e., toward the rod distal end. (FF-8-10.) Richards did not disclose that element 20H *radially inwardly moves* when it is pressed against grooved region 24. To the contrary, a comparison of Richards' Figures 3 and 4 reveals that when the piston 34 has moved to the right toward the rod distal end, element 20H has moved away from the rod center axis 26, i.e., *radially outwardly*. (*Compare* FF-1 *with* FF-2; *see also* App. Br. 10-11.) This movement is in contrast to the relative movement between the distal ends of the plurality of arms and the piston that is required by the independent claims. Therefore, we do not find that Richards disclosed the claimed invention.

CONCLUSION OF LAW

Richards did not disclose a plurality of arms having distal ends that operatively engage with the piston whereby manual movement of the arm distal ends radially inwardly moves the piston axially toward the rod distal end.

SUMMARY

We reverse the rejection of claims 1, 3-10, 12 and 13 under 35 U.S.C. §102(b) as anticipated by Richards.

REVERSED

clj